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EXAMINER	
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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/786,201	CARRO, FERNANDO INCERTIS	
	Examiner	Art Unit	
	Tran A. Quoc	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is a **Final** Office Action on the merits. This action is responsive to "*Response To Office Action*" dated 06-18-2007.

1. Claims 1-23 are pending. Claims 1, 10, 12, 13, 20, and 23 are independent claims.

2. Priority dated 04-26-2000, (Assignee: IBM).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> ***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.***

4. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al., *A framework for interacting with paper*, Eurographics '97, Volume 16, Number 3 – [www.cl.cam.ac.uk/Research/Origami/Origami1997c/index.html] [hereinafter Robison] in view of Moran et al., US 6,326,946 B1 filed 09/17/1998 [hereinafter Moran].

Regarding ***independent claim 1***, Robinson teaches:

a user system connected to a communication network comprising one or more servers.

(See Robinson at the Abstract, and sections 3, 4.4 and 7, discloses user interfaces for computer systems.)

identifying a physical document, the physical document comprising one or identifying a page of the physical document.

(See Robinson at Section 2-para 5, discloses a method of marking the paper documents with a unique identifier.)

identifying the selected marked item by referring to a hyperlink table, the hyperlink table comprising an indication of a position of each marked item on the identified page; identifying information or a service associated with the selected marked item by referring to the hyperlink table, the hyperlink table comprising, for each marked item of each page of the document, identification on a server of the information or the service associated with the selected marked item; and accessing the information or the service associated with the selected marked item.

(See Robinson at Section 4, 4.1, and 4.4, discloses a method of marking the paper documents with a unique identifier, wherein other forms of hypertext can be absorbed into the animated paper document system for importing and exporting. The links is associated with web paper in the Registry, the page can be printed on paper, and links activated by placing the paper on a DigitalDesk and pointing for importing/exporting.)

In addition, Robison does not expressly teach, but Moran teaches:

determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document, the identified page comprising one or more marked items, and the touch foil being pressed at a point corresponding to a selected marked item.

(See Moran Column 2, Line 50 –> Column 3, Line 3, discloses determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents, and the advantage of combining electronic and printed document to give a richer presentation than that afforded by either separated medium (see Robinson at he Abstract).

Claim 2,

Robinson teaches: **accessing a hyperlink table associated with an identified physical document** (Robinson sections 4.1 and 4.4).

Claim 3,

Robinson teaches **determining a destination address in the communications network where the information or service associated with the selected marked item can be accessed** (Robinson sections 4.4 and 7).

Claim 4,

Robinson teaches **an Internet Protocol communications network, servers which are Web servers, a user system comprising Web browsers, a destination address which is a Uniform Resource Locator, and that the information or service comprises at least one Web page** (Robinson sections 3, 4.4, and 7).

Robinson uses mostly commodity hardware and the registry and adaptors are written to work as a distributed system. Commodity hardware forming a distributed system may inherently use Internet Protocol, Web servers, Uniform Resource Locators, a user system comprising Web browsers, and information and services contained on web pages because those are all standards of geographically dispersed networking and one of ordinary skill in the art would have wanted to utilize standard equipment to create a cost effective and compatible system.

Claim 5,

Robinson teaches **wherein the physical document has a form and comprises a physical surface and a material, wherein the physical surface comprises an engraved, a printed, a painted, or a written surface, wherein the material comprises paper, wood, or plastic, and wherein the form comprises a newspaper, magazine, book, catalog, geographical map, photograph, or painting.** Specifically, Robinson disclose in the abstract that the physical document comprises a physical surface made of paper on which is printed ink (Robinson the Abstract).

Claim 6,

Robinson teaches **wherein a marked item on a physical document comprises a word, a letter, an icon, a graphic, a symbol, or a mark.** Specifically, Robinson discloses mark the paper with a reference (Robison Section 2). Moran also teaches this in the abstract.

Claim 7,

Robinson teaches in section 4.4 that the hyperlink table comprises **additional information which may be accessed** and which may include a title, an author, and a date.

Claim 8,

Robinson teaches in section 2 that **the physical document comprises a plurality of pages and that the identified page is one page of the plurality of pages**.

Claim 9,

Robinson does not expressly teach, but Moran does teach:

a touch foil sensitive to pressure exercised over any point in (Moran col. 6 lines 13-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran with Robinson to create the claimed invention. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks, and the advantage of combining electronic and printed document to give a richer presentation than that afforded by either separated medium (see Robinson at he Abstract).

Regarding ***independent claim 10***,

the rejection of claim 1 is fully incorporated.

In addition, **a user system** embodied therein for performance the method of claim 1. Specifically, Robinson discloses user interfaces for computer systems (Robinson the Abstract).

Also, Robinson teaches: **a means for identifying a marked item by referring to a hyperlink table, identifying information associated with the selected marked item by referring to the hyperlink table, and accessing the information associated with the selected marked item** in (Robinson section 4.1)

In addition, Robinson does not teach, but Moran teaches: **a means for determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document or identifying and accessing a service associated with the selected marked item**. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the

marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents, and the advantage of combining electronic and printed document to give a richer presentation than that afforded by either separated medium (see Robinson at he Abstract).

Regarding ***dependent claim 11***, Robinson teaches:

a user system connected to a communication network comprising one or more servers in (Robinson sections 3, 4.4 and 7).

In addition, Robinson does not teach, but Moran teaches: **a transmitting means between the touch foil and the user system for transmitting the position of the points pressed on the touch foil**. Specifically Moran discloses a transmitting means between the touch foil and the user system for transmitting the position of the points pressed on the touch foil in (Moran col. 6 lines 13-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran with Robinson to create the claimed invention. It would be inherently necessary to create a communication link between the touch foil and the user system for the touch foil taught by Moran to be useful, and the advantage

of combining electronic and printed document to give a richer presentation than that afforded by either separated medium (see Robinson at he Abstract).

Regarding ***independent claim 12***,

the rejection of claim 1 is fully incorporated.

In addition, **a computer program on a computer readable medium** embodied therein for performance the method of claim 1. Specifically, Robinson discloses a high- level systems programming language that particularly lends itself to operation in a distributed environment (Robinson section 2).

Also, Robinson teaches: **steps for identifying a marked item by referring to a hyperlink table, identifying information associated with the selected marked item by referring to the hyperlink table, and accessing the information associated with the selected marked item** in (Robinson section 4.1).

In addition, Robinson does not teach, but Moran teaches **steps for determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document or identifying and accessing a service associated with the selected marked item**. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document

in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents, and the advantage of combining electronic and printed document to give a richer presentation than that afforded by either separated medium (see Robinson at he Abstract).

Regarding ***independent claim 13***,

the rejection of claim 1 is fully incorporated.

In addition, Robinson teaches **storing in the hyperlink table an identification of the physical document for each page of the physical document; storing in the hyperlink table an identification of the identified page; storing in the hyperlink table an identification within the communication network of information or a service associated with each marked item; and storing, in the hyperlink table, positions of points**

corresponding to marked items, the hyperlink table comprising, for each marked item, an indication of its position on the identified page.

Specifically, Robinson discloses a method of marking the paper documents with a unique identifier, wherein other forms of hypertext can be absorbed into the animated paper document system for importing and exporting. The links is associated with web paper in the Registry, the page can be printed on paper, and links activated by placing the paper on a DigitalDesk and pointing for importing/exporting (Robinson sections 4, 4.1, and 4.4.), and Robison discloses the registry provides the central directory service for animated paper documents. It stores the image of each active document and the code of any interactors, together with cross-references between these and indexes to identify them (Robinson section 3).

Claim 14,

Robinson teaches in section 4.4: **storing a destination address in the communication network where information associated with a selected marked item can be accessed**.

In addition, Robinson does not teach, but Moran teaches **the service associated with a selected marked item**. Specifically, Moran discloses service associated with a selected marked item (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents, and the advantage of combining electronic and printed document to give a richer presentation than that afforded by either separated medium (see Robinson at he Abstract).

Claim 15,

Robinson teaches **an Internet Protocol communications network, servers which are Web servers, a user system comprising Web browsers, a destination address which is a Uniform Resource Locator, and that the information or service comprises at least one Web page** in (Robinson sections 3, 4.4, and 7). Robinson uses mostly commodity hardware and the registry and adaptors are written to work as a distributed system. Commodity hardware forming a distributed system inherently uses Internet Protocol, Web servers, Uniform Resource Locators, a user system comprising Web browsers, and information and services contained on web pages because those are all standards of geographically dispersed networking and one of ordinary skill in the art would have wanted to utilize standard equipment to create a cost effective and compatible system.

Claim 16,

Robinson teaches **wherein the physical document has a form and comprises a physical surface and a material, wherein the physical surface comprises an engraved, a printed, a painted, or a written surface, wherein the material comprises paper, wood, or plastic, and wherein the form comprises a newspaper, magazine, book, catalog, geographical map, photograph, or painting.** Specifically, Robinson disclose in the abstract that the physical document comprises a physical surface made of paper on which is printed ink (Robinson the Abstract).

Claim 17,

Robinson teaches **wherein a marked item on a physical document comprises a word, a letter, an icon, a graphic, a symbol, or a mark.** Specifically, Robinson discloses mark the paper with a reference (Robison Section 2). Moran also teaches this in the abstract.

Claim 18,

Robinson teaches **storing in the hyperlink table additional information related document, the additional information comprising a title, an author, and a date**. For example, Robison discloses the registry provides the central directory service for animated paper documents. It stores the image of each active document and the code of any interactors, together with cross-references between these and indexes to identify them (Robinson section 3).

Claim 19,

Robinson teaches in the abstract and section 2 that **the physical document comprises a plurality of pages and wherein the identified page is one page of the plurality of pages**.

Regarding ***independent claim 20***,

the rejection of claim 13 is fully incorporated.

In addition, **a user system** embodied therein for performance the method of claim 13. Specifically, Robinson discloses user interfaces for computer systems (Robinson the Abstract).

Claim 21,

Robison teach: **the user system is connected to a communication network comprising one or a plurality of servers,**

(See Robinson sections 3, 4.4, and 7, Robinson uses mostly commodity hardware and the registry and adaptors are written to work as a distributed system. Commodity hardware forming a distributed system may inherently use Internet Protocol, Web servers, Uniform Resource Locators, a user system comprising Web browsers, and information and services contained on web pages because those are all standards of geographically dispersed networking and one of ordinary skill in the art would have wanted to utilize standard equipment to create a cost effective and compatible system.

In addition, Robinson does not teach, but Moran teaches: **s a transmitting means between the touch foil and the user system for transmitting the position of the points pressed on the touch foil**. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents, and the advantage of combining electronic and printed document to give a richer presentation than that afforded by either separated medium (see Robinson at he Abstract).

Claim 22,

Robinson does not teach, but Moran teaches:

wherein the touch foil comprises a transparent touch foil, the touch foil being placed and aligned over the identified page of the physical document. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-14) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3). It would be inherently necessary to create a communication link between the touch foil and the user system for the touch foil taught by Moran to be useful.

Regarding ***independent claim 23,***

the rejection of claim 13 is fully incorporated.

In addition, **a computer program stored on a computer readable medium** embodied therein for performance the method of claim 13. Specifically, Robinson discloses user interfaces for computer systems (Robinson the Abstract), and Robinson discloses a high- level systems programming language that particularly lends itself to operation in a distributed environment (Robinson section 2).

5. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Response to Arguments

6. It is noted, "Notice of Appeal and Pre-Appeal Brief", have been dismissed. Thus the Examiner is not going to address this particular subject matter at this time (see Applicant's submission paper 06-18-2007 and USPTO "Notice of Panel Decision from Pre-Appeal Review" dated 04-30-2007).

7. Applicant's arguments filed 06-18-2007 have been fully considered but they are not persuasive.

Rejection of Claims 1-23 Under 35 U.S.C. § 103(a) (Robinson in view of Moran):

I) Applicant respectfully submits that Robinson and Moran fail to teach, *"an item within the document can be identified and/or used by the system as an operator icon;"* because Moran "*operator icons,* " which may be used to collage physical information composed of components, such as documents, and operator icons is not the same. See *Response* – Page 3, Lines 20-30.

The examiner disagrees.

Firstly, it is noted that the feature upon which Applicant relies (i.e., *"an item within the document can be identified and/or used by the system as an operator icon;"*) is not positively recited in the rejected claims 1, 10,12-13, 20, and 23. That is, Claim 1, 10,12-13, 20, or 23 does not recite any kind of "icon" or an "*operator icon.*" Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Secondly, as explained in the above rejection for 1, 10,12-13, 20, and 23, the system in Robinson discloses a method of marking the paper documents with a unique identifier, wherein other forms of hypertext can be absorbed into the animated paper document system for importing and exporting. The links is associated with web paper in the Registry, the page can be printed on paper, and links activated by placing the paper on a DigitalDesk and pointing for importing/exporting (See Robinson at Section 4, 4.1, and 4.4), Also, (See Robinson at Section 2-para 5, discloses a method of marking the paper documents with a unique identifier.). In addition, Robinson teaches in section 4.1 that it is possible to mark areas of the document as hyperlinks and associate interactors with them. Robinson also teaches in section 4.4 that URL contained in the hyperlink captures the information on the associated web page in the registry. This is the equivalent operation of Applicant's claimed invention's hyperlink table. Moran teaches in col. 6 lines 14-20 that a touch foil embodiment may be used to identify the textual or graphic material in col. 5 Line 16 which may be linked to a digital service.

II) Applicant respectfully submits that Robinson and Moran fail to teach, *"items within a physical artifact can be used;"* because Moran "*touch foil,* " is not the same. See *Response* – Page 4, Lines 15-20.

The examiner disagrees.

Firstly, as explained in the above rejection for 1, 10,12-13, 20, and 23, the system in Robinson discloses determining a position of a point pressed on a "*touch foil*" which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item, also (see Moran Column 2, Line 50 –> Column 3, Line 3).

Secondly, It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents, and the advantage of combining electronic and printed document to give a richer presentation than that afforded by either separated medium (see Robinson at he Abstract).

III) Applicant respectfully submits that Robinson and Moran fail to teach, *"the touch foil being placed and aligned over or under the identified page of the physical document"* because Moran "*alignment*", which a user can move any physical artifact 32 to any position. See *Response* – Page 4, Lines 20-30.

The examiner disagrees.

Firstly, as explained in the above rejection for 1, 10,12-13, 20, and 23, the system in Robinson teaches identifying a selected marked item by referring to a hyperlink table, identifying information with the selected marked item by referring to the hyperlink table, and accessing the information associated with the selected marked item in sections 4, 4.1, and 4.4. What Robinson does not teach is determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document and identifying and accessing a service associated with a selected marked item. Moran does teach determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in col. 6 lines 13-19 and identifying and accessing a service associated with a selected marked item in col. 2 line 50 – col. 3 line 3.

Secondly, Moran discloses putting a person icon next to a task card can assign the task to the person and email a reminder to the person. The implicit actions on the board of the information collage will generally require the system to recognize and interpret spatial relationships (e.g., adjacency, alignment, enclosure) among collage

components, diagrammatic annotations (e.g., encirclements or links), manual gestures, or other modes of interactions with the collage (See Moran Column 3, Lines 35-40).

IV) Applicant respectfully submits that, *"one skilled in the art would not be motivated to combine Robinson and Moran"*, See *Response* – Page 4, Line 31 → Page 5, Line 31.

The examiner disagrees.

Following KSR direction as following: "SUPREME COURT OF THE UNITED STATES No. 04–1350 KSR INTERNATIONAL CO., PETITIONER v. TELEFLEX INC. ET AL. ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT [April 30, 2007], (page 2-3 of the court opinion) Following Graham v. John Deere Co. of Kansas City, 383 U. S. 1 (1966), the Court set out a framework for applying the statutory language of §103, language itself based on the logic of the earlier decision in Hotchkiss v. Greenwood, 11 How. 248 (1851), and its progeny. See 383 U. S., at 15–17. The analysis is objective:

> "Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Id., at 17–18.

While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under §103. Seeking to resolve the question of obviousness with more uniformity and consistency, the Court of Appeals for the Federal Circuit has employed an approach referred to by the parties as the "teaching, suggestion, or motivation" test (TSM test), under which a patent claim is only proved

obvious if "some motivation or suggestion to combine the prior art teachings" can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art. See, e.g., Al-Site Corp. v. VSI Int'l, Inc., 174 F. 3d 1308, 1323–1324 (CA Fed. 1999). KSR challenges that test, or at least its application in this case. See 119 Fed. Appx. 282, 286–290 (CA Fed. 2005). Because the Court of Appeals addressed the question of obviousness in a manner contrary to §103 and our precedents, we granted certiorari, 547 U. S ___ (2006). We now reverse.

Using the broadest reasonable interpretation, and cites evidences above, the Examiner had found that:

Firstly, as explained in the above rejection for 1, 10,12-13, 20, and 23, the system in Robinson discloses determining a position of a point pressed on a "*touch foil*" which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item, also (see Moran Column 2, Line 50 –> Column 3, Line 3).

Second, as explained in the above rejection for 1, 10,12-13, 20, and 23, the system in Moran further determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in col. 6 lines 13-19 and identifying and accessing a service associated with a selected marked item in col. 2 line 50 – col. 3 line 3. Also, Moran discloses putting a person icon next to a task card can assign the task to the person and email a reminder to the person. The implicit actions on the board of the information collage will generally require the system to recognize and interpret spatial relationships (e.g., adjacency, alignment, enclosure) among collage components, diagrammatic annotations (e.g., encirclements or links), manual gestures, or other modes of interactions with the collage (See Moran Column 3, Lines 35-40).

Thirdly, Using the broadest readable interpretation, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents, and the advantage of combining electronic and printed document to give a richer presentation than that afforded by either separated medium (see Robinson at he Abstract).

Thus the examiner has established "some motivation or suggestion to combine the prior art teachings" can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art. See, e.g., Al-Site Corp. v. VSI Int'l, Inc., 174 F. 3d 1308, 1323–1324 (CA Fed. 1999). KSR challenges that test, or at least its application in this case. See 119 Fed. Appx. 282, 286–290 (CA Fed. 2005).

Therefore the Examiner respectfully maintains the rejection of claims 1-23 at least at this time based on the Office action dated 01-24-2007 and all the above evidences.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on 9AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A, Tran
Patent Examiner
Technology Center 2176
July 24, 2007

7/24/2007

/Doug Hutton/
Primary Examiner
Art Unit 2176